

REMARKS

This is a fully and timely response to the Official Action mailed on March 11, 2004 (Paper No. 13). Reconsideration of the application in light of the foregoing amendments and the following remarks is respectfully requested.

No claims are added or cancelled by the present amendment. Claims 37-43 have been withdrawn under a Restriction Requirement. Consequently, claims 1-36 are currently pending for consideration.

In the outstanding Office Action, claims 37-43 were held as being directed to an independent or distinct invention from that originally claimed. Consequently, claims 37-43 are withdrawn from consideration under a Restriction Requirement. Application respectfully traverses this Restriction Requirement as improper and defective.

First, the Action fails to explain how the invention of claims 37-43 is independent or distinct from that of claims 1-36. According to MPEP § 802.02, the examiner “must provide reasons and/or examples to support conclusions” regarding a Restriction Requirement, i.e., explaining how the two inventions are independent or distinct. Consequently, the Restriction of claims 37-43 is improper because the burden of supporting the Restriction has not been met in the outstanding Action.

Second, the outstanding Office Action mentions that Applicant has received an action on the merits in this application and has therefore constructively elected the “previously claimed invention” by original presentation. In response, Applicant wishes to point out that claims 37-43 were added in a preliminary amendment filed with a Request for Continued Examination which restarts the examination of the application. Thus, the doctrine of election by original presentation does not apply in this case.

For at least these reasons, the Restriction of claims 37-43 should be reconsidered and withdrawn. If the Restriction is maintained, Applicant expressly requests adequate evidence be made of record to support the holding that (1) the invention of claims 37-43 is independent or distinct from that of the other claims, and (2) it would be a serious burden to examine both sets of claims in this application. MPEP § 802.02. Otherwise, a Restriction is improper.

Next, the Action objected to minor informalities in claim 27. Claim 27 has consequently been amended to remove the informalities and is now thought to be in proper form. Therefore, the objection to claim 27 should now be withdrawn.

With regard to the prior art, the Office Action rejected claims 1-3, 7-13, 16-24, and 26-27 as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 5,574,495 to Caporizzo. (“Caporizzo”) and U.S. Patent No. 6,351,773 to Filjolek et al. (“Filjolek”). The other dependent claims in the claim set of claims 1-27 are all rejected based on the combination of Caproizzo and Filjolek in combination with various additional secondary references. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A method of locating set-top terminals within a cable television system and using location information for said terminals to improve efficient operation of said cable television system, the method comprising:

with a system controller, automatically determining which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal that has not communicated with the system controller previously; and

identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal;

wherein a location of said set-top terminal within said system comprises an identification of said upstream plant and said associated downstream plant.  
(emphasis added)

Similar subject matter is recited in independent claims 11 and 20.

In contrast, the combined teachings of Caporizzo and Filjolek fail to teach or suggest the claimed subject matter. Caporizzo and Filjolek do not teach or suggest a system controller that “automatically determin[es] which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal that has not communicated with the system controller previously.”

In the first place, Filjolek is wholly irrelevant to the claimed invention. Filjolek teaches nothing about set-top terminals in a cable television system, or the interaction between a set-top terminal and a system controller. Filjolek does not even mention a set-top terminal.

Rather, Filjolek deals exclusively with personal computers (CPE) that are connected to the Internet or other computer network using a cable modem (CM) and cable network. (Col. 5, lines 31-33 and lines 41-43; col. 23, lines 42-45; and col. 23, lines 60-65). Those portions of Filjolek cited in the Office Action have to do with a personal computer (CPE) communicating with a computer network via a cable modem (CM), and have nothing whatsoever to do with a set-top terminal or corresponding system controller.

The Office Action concedes that Caporizzo is silent on teaching a set-top terminal that has not previously communicated with a system controller. (Paper No. 13, p. 4). Consequently, Filjolek is specifically cited as teaching a device, newly connected to a cable network, that sends out a first message to identify itself to the system. Filjolek, however, teaches nothing of the kind. Rather, Filjolek, as cited, merely states that a Cable Modem Termination System (CMTS) knows the location of a cable modem (CM) because it sends the

CM one or more initialization messages. (Col. 17, lines 50-55). Filjolek does not teach or suggest any device, new to a cable system, that transmits a message to a system controller so that the controller can locate the device using that message. The recent Office Action has failed to identify any portion of Filjolek that teaches such subject matter.

Thus, the combination of Caporizzo and Filjolek fails to teach or suggest the claimed system controller that automatically locates a particular set-top terminal based on a first message sent to the system controller from that particular set-top terminal, where that set-top terminal has not communicated with the system controller previously.

Furthermore, Caporizzo is cited as teaching a system controller that determines an upstream plant from among a plurality of upstream plants used by the set-top terminal to transmit that first message. However, as Applicant has previously pointed out, Caporizzo only teaches storing a downstream plant for a set-top terminal and does not teach or suggest determining a set-top terminal's upstream plant. The Office Action fails to respond to this point.

As previously explained, Caporizzo teaches that "*the headend 15 includes a database of the entire CATV network topology. As part of the cable system customer database each subscriber is identified by specifying a specific address. For example, a settop terminal 10 located on cable system trunk number 2, line extender 1, with settop Ser. number 7784 will have a terminal identification number of 217784.*" (Col. 6, lines 5-10) (emphasis added). The headend then uses the addresses already in the database to communicate *downstream* (i.e., to poll) specific set-top terminals. (Col. 6, line 10).

Thus, Caporizzo teaches a database *already at the headend* which includes addresses that specify a *downstream* path for each set-top terminal. These addresses are apparently not

created by the headend, but are provided to the headend as set-top terminals are manually added to the system. *These addresses specify a downstream path to a set-top terminal and do not represent or designate an upstream plant for each set-top terminal. As will be appreciated by those skilled in the art, a downstream path to a set-top terminal is not necessarily the same thing as an upstream path used by that set-top terminal.*

Consequently, Caporizzo and Filjolek, taken together, do not teach or suggest that the headend or "system controller" "automatically determine[es] which upstream plant from a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal that has not communicated with the system controller previously." "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 1-3, 7-13, 16-24, and 26-27 based on Caporizzo and Filjolek is deficient and should be reconsidered and withdrawn.

Additionally, the recent Office Action provides no explanation of either how or why the teachings of Caporizzo would be modified by those of Filjolek. The Office is required to explain how and why references are combined in making an obviousness rejection. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added).

Therefore, for at least the additional reason that the Office Action fails to explain how or why the teachings of Caporizzo and Filjolek would be combined, the rejection of claims 1-3, 7-13, 16-24, and 26-27 is deficient and should not be sustained.

Independent claim 28 was rejected under 35 U.S.C. § 103(a) over the combined teachings of Caporizzo and Filjolek in further combination with Henderson (1998 IEEE) (“Henderson”). Those claims that depend from claim 28 were similarly rejected in view of the teachings of Caporizzo, Filjolek and Henderson, or Caporizzo, Filjolek and Henderson in further combination with one or more additional secondary references. For at least the following reasons, these rejections are respectfully traversed.

Claim 28 recites:

A method of adding a set-top terminal to a cable television system, said method comprising:

selling a set-top terminal through a retail distribution model in which a subscriber purchases the terminal at a retail outlet and installs the terminal;

connecting said set-top terminal to said cable television system without advance notice to operators of said cable television system;

with a system controller, automatically determining which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal; and

identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal;

wherein a location of said set-top terminal within said system comprises an identification of said upstream plant and said associated downstream plant.

(emphasis added).

The recent Office Action admits that Caporizzo is silent on purchasing a set-top terminal. (Paper No. 13, p. 9) To be precise, Caporizzo and Filjolek fail to teach or suggest selling a set-top terminal directly to a subscriber through a retail outlet. Caporizzo and Filjolek also fail to teach or suggest the subscriber installing the terminal without advance notice to the operators of the cable television system.

Henderson is apparently cited to file in these gapping holes. However, Henderson merely states that "Consumers will be able to purchase digital receivers at a variety of price points." (p. 4, 1<sup>st</sup> paragraph). Thus, Henderson also does not teach or suggest selling a set-top terminal through a retail distribution model including a retail outlet. Henderson also does not teach or suggest that the set-top terminal is installed by the purchasing subscriber. Henderson also does not teach or suggest that the set-top terminal is connected to the cable system without advance notice to the system operators.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). *Accord*. M.P.E.P. § 706.02(j). Clearly, the cited combination of prior art references fails to teach or suggest many of the features of claim 28. Therefore, the rejection of claims 28-36 should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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